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DE RUEHGV #0559/01 1871517
ZNR UUUUU ZZH
R 061517Z JUL 09
FM USMISSION GENEVA
TO RUEHC/SECSTATE WASHDC 8814
INFO RUCPDOC/DEPT OF COMMERCE WASHINGTON DC

UNCLAS GENEVA 000559

SIPDIS

SECSTATE FOR EEB
COMMERCE FOR USPTO

E.O. 12958: N/A
TAGS: [ECON](#) [KIPR](#) [WIPO](#)
SUBJECT: WIPO meeting on Trademarks, Industrial Designs, and Geographical Indications

¶1. SUMMARY: The 21st session of the Standing Committee on Trademarks (SCT) was productive and collegial, even though the Committee was somewhat split over a Jamaican proposal to add country name protection to the provisions of Article 6ter of the Paris Convention, as symbols of national sovereignty. Having learned lessons from other WIPO standing committees, the SCT agreed to continue discussion on the Jamaican proposal--even though there were some who were adamantly opposed to further discussion--giving the Jamaicans "due process" instead of cutting off debate entirely. Many delegations were concerned that cutting off debate would merely send the issue to another WIPO or WTO forum. END SUMMARY

¶2. The Twenty-First session of the World Intellectual Property Organization's Standing Committee on the Law of Trademarks, Industrial Designs, and Geographical Indications (SCT) was held from June 22-26, 2009, in Geneva. Mr. Park Seong-Joon (Republic of Korea) was elected as Chair of the SCT for the 21st session while Mr. Adil El Maliki (Morocco) was elected as Chair of the Twenty-Second session of the SCT. The United States was represented by Amy Cotton, John Rodriguez, and Janis Long, United States Patent and Trademark Office (USPTO), Nancy Omelko, IP Attaché at the US Mission to the WTO, and Deborah Lashley-Johnson, IP Attaché at the US Mission to the UN.

Industrial Designs

¶3. Several sessions ago, Norway proposed that the SCT begin work on industrial design formality issues with the potential goal of a Diplomatic Conference for a design law treaty (DLT), similar to the Patent Law Treaty (PLT) or the Trademark Law Treaty (TLT). The SCT began discussions on a document, SCT/21/4, which outlined possible "areas of convergence" that might be ripe for an eventual basic text for a design formalities treaty.

¶4. The United States protects industrial designs, as identified in the WTO Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS), via the U.S. design patent system. Many other countries around the world protect designs through a *sui generis* design registration system with little to no examination as to novelty--at least until a claim of infringement is made - and with minimal time to registration, as well as a relatively short term of protection, with possible renewals.

¶5. Discussion of the document was tedious, as the new Chair struggled to find common ground amongst the various regimes. Areas of particularly divergent practice include: specimens; filing date requirements; deferment of publication and secret design; grace period in the event of disclosure; term of protection; and attestation or authentication of communications. The delegations struggled to determine whether the existing text could be rewritten to accommodate all systems, or whether a new document should be drafted that better reflected the areas where no convergence was possible.

¶6. From the perspective of the United States, it is potentially premature to work on design formalities when the United States and many others have yet to implement the Geneva Act of the Hague Agreement for the Registration of Industrial Designs. Implementing the Hague Agreement will necessitate various changes to U.S. law and practice that will likely harmonize international practice in some areas. However, until the United States has further consultations with U.S. industry and Congress, there is little incentive or flexibility for the USDEL to fully engage in any in-depth harmonization discussions on this issue. The IB will prepare a revised working document on possible areas of convergence to be considered at the next session.

Trademark Grounds of Refusal

¶7. The SCT discussed document SCT/21/2, based on submissions by delegations as to national practice. As this is such a broad topic, it was difficult to determine an appropriate way to structure these discussions so as to continue the lively and informative dialogue amongst delegates without a real harmonization deliverable. Delegations are invited to share further information as to specific grounds of refusal that would be of most interest to them, including specific cases of office practice as well as examples. The document will be revised to reflect these submissions.

Certification and Collective Mark Formalities

¶8. Discussions on this document, SCT/21/3, were a bit strained as it appeared that many delegations had limited experience in handling

certification and collective mark applications. The USDEL began the discussion by asking specific questions on national policy and practice relating to 5 areas that U.S. stakeholders have identified as problematic when filing for registration in other countries: a) what to apply for if a country does not register certification marks; b) how to establish "proof of authority" for purposes of demonstrating whether the applicant has governmental sanction to run a certification program; c) how to classify certified goods; d) what sort of regulations or standards are necessary to satisfy national offices; and f) what constitutes an applicant, a producer group or a certifier who does not produce the goods. The Secretariat will prepare a revised paper based on the discussions for the next session.

Article 6ter of the Paris Convention

¶9. The delegation of Jamaica introduced its proposal to reopen the Paris Convention in order to extend Article 6ter's protection for symbols of state sovereignty to include country names, including in translation, in abbreviated or adjectival form, as well as in any homonymous forms. The Jamaican delegation argued that there is a loophole in Article 22 of the TRIPS Agreement which does not provide for geographical indication protection for services, only for goods. Therefore, the delegation wanted to address that loophole with this extension of Article 6ter to country names. The delegation referenced development discussions at WIPO in its opening intervention.

¶10. An informal polling of various delegations indicated that Jamaica was fairly isolated in its position, with the exception of Switzerland. However, there was sensitivity to the fact that the delegation from Jamaica needed to achieve some progress at the SCT or it would be likely to raise the issue in other committees, where the debate and the outcome would likely be less substantive and more political.

¶11. Ultimately, the SCT agreed to the preparation of a draft questionnaire soliciting input from delegations as to how trademark applications containing or consisting of country names would be handled at the national level. The USDEL indicated a desire to broaden the questionnaire to touch on the broader issue of

geographic deceptiveness, in an effort to advance the SCT discussions of grounds of refusal and to more properly focus the Jamaican proposal.

¶12. The Twenty-Second session of the SCT is tentatively set for November 23-26, 2009, in Geneva.

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